



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION

OF: KRÄMER ET AL.

SERIAL No. 10/015,559

FILED: DECEMBER 17, 2001

FOR: USE OF CHROMAN DERIVATIVES IN COSMETIC OR DERMATOLOGICAL PREPARATIONS

Box: AF

CONFIRMATION No.: 6211

GROUP ART UNIT: 1617

EXAMINER:
RUSSELL S. TRAVERS

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, PO Box 1450, Alexandria, VA 22313-1450, on:
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Date of Signature

Honorable Commissioner
for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. §1.181

Sir:

Applicants hereby petition to the Honorable Commissioner to withdraw from final rejection the above-identified pending application and require the Examiner to provide a non-final action.

On the facts which are summarized below, applicants respectfully suggest that their amendment dated October 31, 2003 (*date of the Certificate of Mailing; Paper No. 05*) did not necessitate the new ground of rejection which was raised by the Examiner in the final Office action of February 12, 2004 (*Paper No. 07*), and thus the Office action asserting such a new ground should be a non-final rejection to provide applicants with a full and fair time period to respond to such new ground of rejection.

SUMMARY OF MATERIAL FACTS:

1. The application was filed in the U.S. pursuant to the provisions of Section 111 of the Patent Act on December 17, 2001.

2. A first written action in the application issued on the merits of the claimed subject matter on July 02, 2003 (*Paper No. 04*). In the Office action the Examiner *inter alia* rejected applicants' Claims 9 and 10 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Jiang et al.*¹⁾. No further prior art rejections were raised by the Examiner in that Office action.

3. On October 31, 2003 (*date of Certificate of Mailing; Paper No. 05*), applicants submitted a reply along with a request and fee for a one month extension of time. With the reply, applicants submitted and amendment whereby *inter alia* Claim 9 was amended to read on the subject matter of Claim 10 and Claim 10 was canceled.

4. On January 22, 2004 (*date of Certificate of Mailing; Paper No. 06*), applicants submitted a supplemental information disclosure statement along with the requisite fee set forth in Rule 17(p). In addition to patent documents, the following other documents were submitted:

- Patent Abstract of Japan, abstract of JP 57/145871
- Placer et al., *Die Nahrung* 12(4), 491-492 (1968)
- Derwent Abstract of JP 1999/093876; and
- Jiang et al., *PNAS* 97(21), 11494-11499 (2000).

5. The Examiner issued a second Office action on the merits on February 12, 2004 (*Paper No. 07*), and made the Office action final. In the final Office action the Examiner rejected *inter alia* Claim 9 under 35 U.S.C. §103(a) based on the teaching of *Jiang et al.* when taken in view of the teaching of *Burton et al.*²⁾. The secondary reference of *Burton et al.* was not submitted by applicants in the supplemental information disclosure statement dated January 22, 2004. The secondary reference of *Burton et al.* was introduced into the proceedings by the Examiner in the PTO-892 form included in the final action.

6. This Petition follows.

1) 134 CA: 759916, 2000; corresponding to *PNAS* 97(21), 11494-11499 (2000).

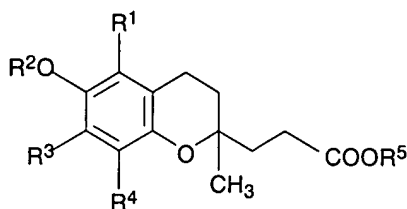
2) *J. Am. Chem. Soc.* 107, 7053-7065 (1985)

M E M O R A N D U M

It is applicants position that the amendment of Claim 9 which was submitted with the reply dated October 31, 2003, did not necessitate the new ground of rejection, cf. the rejection of Claim 9 under 35 U.S.C. §103(a) based on the teaching of *Jiang et al.* when taken in view of the teaching of *Burton et al.* which was raised by the Examiner for the first time in the final Office action, and that the finality of said Office action with such new ground is thus improper.

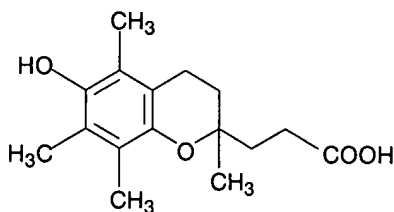
Claims 9 and 10 as submitted by applicants upon filing of the application read as follows:

9. A cosmetic preparation for protecting the human epidermis or human hair, which comprises, in a cosmetically suitable carrier, a cosmetically effective amount of at least one of the compounds of the formula I



in which the substituents R^1 to R^5 have the meanings defined according to claim 1.

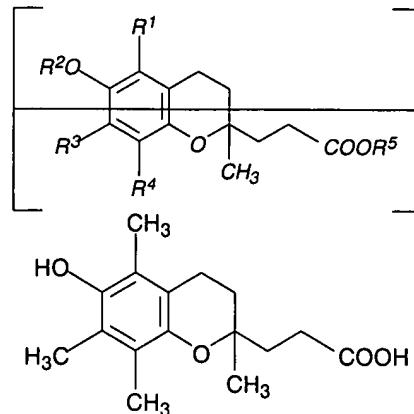
10. A cosmetic preparation as claimed in claim 9, comprising a cosmetically effective amount of the compound of the formula Ia



Ia.

The changes which were made by applicants in Claim 9 in the amendment submitted with the reply dated October 31, 2003, merely served to represent the subject matter defined in original Claim 10 in independent form, as apparent from the copy of Claim 9 as amended and including the markings of changes made in Claim 9:

9. (currently amended) A cosmetic preparation for protecting the human epidermis or human hair, which comprises, in a cosmetically suitable carrier, a cosmetically effective amount of [~~at least one of the compounds~~] a chroman of [~~the~~] formula Ia



[4]

1a.

~~[in which the substituents R¹ to R⁵ have the meanings defined according to claim 1.]~~

MPEP §706.07(a) "Final Rejection, When Proper on Second Action" explains that

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Applicants' amendment of Claim 9 merely provides that the subject matter previously defined in Claim 10 is presented in independent form. As such, applicants' amendment cannot be considered to have necessitated the new ground of rejection. Moreover, the new ground of rejection raised by the Examiner is not based on information submitted by applicants pursuant to Rule 97(c). The circumstances here are therefore fully consonant with the exception made in MPEP §706.07(a). MPEP §706.07(a) also provides that

a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Based on the subject matter originally defined in applicants' Claim 10, the changes which were made by applicants are merely editorial in nature and cannot be considered as an amendment which necessitate

additional art. As such, the circumstances in which "a second or any subsequent action on the merits in any application ... will not be made final" should also fully apply to the current situation.

It is further respectfully submitted that MPEP §706.07(c) states that

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

(emphasis added), and that

... in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

The fact that the Examiner raised a new rejection, based on prior art not of record, in a final action is deemed to deprive applicants of their right to a full and fair hearing on the issue to which they are entitled. Moreover, the Examiner's action is deemed to prevent that the newly raised issue is clearly developed between the Examiner and applicants prior to appeal.

C O N C L U S I O N

Applicants therefore respectfully request that the finality of the Examiner's action dated February 12, 2004, be withdrawn and that the application be returned to the Examiner for entry and full consideration of applicants' reply of even date with this petition (Paper No. 09) as a timely reply under Rule 111. Favorable action is respectfully solicited.

REQUEST FOR EXTENSION OF TIME:

A request for a two month extension of time pursuant to Rule 136(a) including the appropriate fee is submitted by applicants in their reply of even date with this petition.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,
KEIL & WEINKAUF

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